

Applic. No. 09/667,281

Amdt. dated November 12, 2003

Reply to Office action of August 12, 2003

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1, 7-11, and 17-20 remain in the application. Claims 1, 8, 11, and 18 have been amended. Claims 2 and 12 have been cancelled.

In item 2 on page 2 of the Office action, claims 1, 7-11, and 17-20 have been rejected as being obvious over Kinkaid (U.S. Patent No. 3,264,599) in view of Wanger et al. (U.S. Patent No. 5,280,467) (hereinafter "Wanger") under 35 U.S.C. § 103.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found in claims 2 and 12 of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 has been amended to include the subject matter of claim 2, which was not rejected over the above-mentioned combination of references. Therefore, claim 1 is believed to

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be allowable over Kinkaid in view of Wanger. Claim 11 has been amended to include the subject matter of claim 12, which was not rejected over the above-mentioned combination of references. Therefore, claim 11 is believed to be allowable over Kinkaid in view of Wanger.

In item 3 on page 3 of the Office action, claims 2 and 12 have been rejected as being obvious over Kinkaid (U.S. Patent No. 3,264,599) and Wanger (U.S. Patent No. 5,280,467) in further view of Bauer (U.S. Patent No. 5,161,991) under 35 U.S.C. § 103. Since the subject matter of claim 2 has been added to claim 1 and the subject matter of claim 12 has been added to claim 11, this rejection will be discussed relative to claims 1 and 11.

Claims 1 and 11 call for, *inter alia*:

the plastic member having a conducting surface, and the conducting surface electrically contacting the material and being disposed at a respective spacing distance from the contact pins.

Applicants comment as follows with regard to the Examiner's comments that it would have been obvious to one of ordinary skill in the art at the time the invention was made to further

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modify Kinkaid by constructing the plastic member (2) as taught by Bauer in order to provide an additional ESD protection device and to protect the sensitive electronic components from damage due to electrostatic discharge during mating with the connector (6).

It is applicants' position that the teaching of Bauer does not provide a person of ordinary skill in the art any teaching towards the subject matter of claim 1. In Bauer an air gap (24) is disposed between a plate (22) connected with ground and tails (18). The air gap is dimensioned such that at a predetermined voltage, the current associated with the voltage can flow from the tails (18) to the plate (22) (column 2, lines 49-54).

A person of ordinary skill in the art is not provided any teaching to replace the air gap disclosed in Bauer with a material having conductive properties at voltages above a given working voltage range and having insulating properties at voltages in the given working voltage range as recited in claims 1 and 11 of the instant application.

Furthermore, a combination of Kinkaid, Wanger and Bauer does not obviate the invention of the instant application as claimed. Instead, based on the teaching of Wagner, a person

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of ordinary skill in the art would either manufacture the plastic body (2) disclosed in Kinkaid entirely from the material having the surface resistance disclosed in Wanger, or they would manufacture the plastic body (2) disclosed in Kinkaid with a common plastic material and provide it with a surface coating as disclosed in Wanger so the it would have the desired surface conductivity.

As discussed above, the references do not show or suggest the plastic member having a conducting surface, and the conducting surface electrically contacting the material and being disposed at a respective spacing distance from the contact pins, as recited in claims 1 and 11 of the instant application.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999).

Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the

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invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole,

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rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either

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show or suggest the features of claims 1 or 11. Claims 1 and 11 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1 or 11, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1, 7-11, and 17-20 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,



For Applicant(s)

**Alfred K. Dassler**  
**52,794**

AKD:cgm

November 12, 2003

Lerner and Greenberg, P.A.  
Post Office Box 2480  
Hollywood, FL 33022-2480  
Tel: (954) 925-1100  
Fax: (954) 925-1101